

09/554,531
Response Under 37 CFR 1.111

Patent
238/087US

REMARKS

With this response, the specification has been amended as requested by the Examiner to provide the missing U.S. application serial number on page 5, line 2. Also, as requested by the Examiner, an abstract has been provided.

With this response, claims 1-31 and 33-71 have been amended. Claims 2-28, 30, 43-66 and 68-71 have been amended to replace "a" with "the." These amendments do not change the scope of the claims. No new matter has been added by the amendments. No claims have been cancelled. Thus, the currently pending claims are 1-73.

Election of Species

Applicants acknowledge and thank Examiner with withdrawing the requirement for an election of species mailed March 26, 2002.

Claim Objections

In the Office action, claims 1, 29, 33-35, 36-38, 39-41, 42, 67 and 70 were objected to because of informalities. With this response, claims 1 and 29 have been amended to replace the semi-colon at the end of the claims with a period. A period has also been added to the end of claim 70. In claim 29, the duplicative "Xaa₅" has been deleted and replaced with "Xaa₄" to correct an obvious numbering error. Also in claim 29, "Xaa₁₈" has been deleted to allow for proper numbering of the amino acids. In claims 33-35, the phrase "the administration of" has been replaced with "administering to a patient in need thereof" as suggested by the Examiner. Applicants contend that this amendment does not narrow the scope of the claims. In claims 36-38, the phrase "the administration of" has been replaced with "administering" as suggested by the Examiner. Again, Applicants contend that this change does not narrow the scope of the originally filed claims. Claims 39-41 have been amended to insert the phrase "to the mammal" as suggested by the Examiner. Applicants assert that this amendment does not add an additional limitation to the claim, but restates a limitation found in the preamble. Claim 41 has been amended to replace "hypoglycemic" with "hyperglycemic" as suggested by the Examiner. In claim 42, the "or" after "Leu" has been removed and the phrase "Ala, Leu, or" moved to the beginning of the clause. This change does not alter the scope of

09/554,531
Response Under 37 CFR 1.111

Patent
238/087US

the claim, but is made for grammatical purposes only. In the Office action, claim 67 was objected to as being duplicative of claim 59. With this response, claim 67 has been amended so that it is no longer duplicative of claim 59. In the Office action, claim 31 was objected to as being a multiple dependent claim. With this response, claim 31 has been amended to remove the multiple dependency.

Non Art-Based Rejections

Rejections Under 35 U.S.C. 112, Second Paragraph

In the Office action, claims 1-28, 33, 34, 36, 37, 39, 40, and 42-73 were rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In light of the present amendments, Applicants respectfully request reconsideration and withdrawal of these rejections.

In the Office action, claims 1 and 42 were rejected as indefinite because the substituent Xaa₃₉ was not defined. With this response, claims 1 and 42 have been amended to recite that Xaa₃₉ is Ser or Tyr. Support for the amendments to claims 1 and 42 can be found at page 20, line 8, and page 12, lines 22-23, respectively, of the specification.

In the Office action, claim 17 was rejected as indefinite for lack of antecedent basis for the limitation "wherein Xaa₆ is Ala" in line 1. Claim 1, from which claim 17 ultimately depends, has been amended to recite that Xaa₆ can be Ala. Likewise, claim 29 has also been amended to recite that Xaa₆ can be Ala. Support for these amendments can be found on page 19, lines 23-24, of the specification which states that preferred compounds of formula (I) are those where Xaa₆ is Ala, Phe or naphthylalanine.

In the Office action, claims 20-23 were rejected as indefinite for lack of antecedent basis for the limitation "wherein Xaa₃₉ is Ser or Tyr." Applicants submit that presently amended claim 1 provides proper antecedent basis for these claims.

In the Office action, claim 58 was rejected as indefinite for lack of antecedent basis for the limitation "wherein Xaa₆ is Ala." With this response, claim 42, from which claim 58 depends, has been amended to recite that Xaa₆ can be Ala. Support for this amendment can be found on page 26, line 10, of the specification which states that

09/554,531
Response Under 37 CFR 1.111

Patent
238/087US

preferred compounds of formula II are those in which Xaa₆ is Ala, Phe or naphthylalanine.

In the Office action, claims 61-64 were rejected as indefinite for lack of antecedent basis for the limitation "wherein Xaa₃₉ is Ser or Typ" and "wherein Xaa₃₉ is Ser." Applicants submit that presently amended claim 42 provides proper antecedent basis for these claims.

In light of the above remarks and amendments, Applicants respectfully request reconsideration and withdrawal of all rejections under 35 U.S.C. 112, second paragraph.

Rejections Under 35 U.S.C. 112, First Paragraph

Applicants acknowledge that no claims have been rejected under 35 U.S.C. 112, first paragraph.

Art-Base Rejections

Applicants acknowledge Examiner's finding that all currently pending claims are free from the prior art because the prior art does not teach or fairly suggest Applicants' claimed compounds, compositions and method of use.

09/554,531
Response Under 37 CFR 1.111

Patent
238/087US

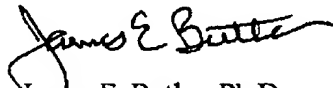
Conclusion

In light of the foregoing amendments and remarks, Applicants respectfully request reconsideration and withdrawal of all rejections set forth in the Office action of February 27, 2004. Further, Applicants respectfully submit that all claims presently under consideration are in a condition for allowance and request issuance of a Notice of Allowance at the Examiner's earliest convenience.

Should the Examiner have any remaining questions regarding the subject invention or its patentability, Applicants encourage the Examiner to contact the undersigned to answer such questions or provide additional information.

Applicants believe that no fee is due in association with this response. If the Applicants are in error, the Commissioner is hereby authorized to charge any underpayment or credit any overpayment that may occur during the pendency of this application to Deposit Account No. 01-0535.

Respectfully submitted,


James E. Butler, Ph.D.
Registration No. 40, 931

AMYLIN PHARMACEUTICALS, INC.
9360 Towne Centre Drive
San, Diego, CA 92121
Voice: (858) 458-8564
Fax: (858) 552-1936